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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,776	05/22/2000	Cheryl Henry	H546.12-0001	2785

28020 7590 11/08/2002

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EXAMINER

VORTMAN, ANATOLY

ART UNIT	PAPER NUMBER
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2835

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/575,776

Applicant(s)

HENRY, CHERYL

Examiner

Anatoly Vortman

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120.**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over US/5,566,290 to Silverbrook.

Regarding claims 1 and 6, Silverbrook disclosed (Fig. 1 and 2) a portable apparatus (1) for reading only file directory information stored on a separately portable self contained data storage device (11), the portable apparatus not in communication with a personal computer, the apparatus comprising:

a handheld housing (2, 9) (the housing may be held in hands if so desired);

a drive component (79) for reading the file directory information on the data storage device (11), (column 2, lines 4+);

a loading mechanism (79) for receiving the data storage device (11) and retaining the data storage device such that the drive component (79) reads the file directory information on command (column 2, lines 4+);

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a processor (70) programmed to read and communicate only file information (please, note, that any computer data, including video information is contained in files. Thus, said processor (70), inherently reads and communicates only a file (image file) information (column 2, lines 64+; column 3, lines 65+; column 4, lines 1+)); and,

a visual display (4) operably connected to the drive component through the processor (70) for viewing the file information contained on the data storage device (11), but did not explicitly stated that said file information is only the file directory information.

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to view any desirable information on said visual display, including only the file directory information, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claims 6 and 16, Silverbrook further disclosed a printer (an output device) operably connected to the drive component to print the file directory contents contained on the display (4), (column 3, lines 45+).

Regarding claims 13 and 14, Silverbrook disclosed at least one data storage drive (79 or 78) for reading the file directory information from at least one respective type of data storage device (11 or 21); and a visual display output device (4) for providing the file directory information contained on the data storage device (11 or 21).

Regarding claim 2, Silverbrook disclosed a printer (column 3, lines 45+) to print the file directory information retrieved from the data storage device (11) by the drive component (79).

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Regarding claims 3 and 15, Silverbrook disclosed that the visual display (4) is a liquid crystal display (column 1, line 66).

Regarding claims 4 and 19, Silverbrook disclosed that the drive component reads magnetic storage media (21), (column 2, lines 26+).

Regarding claims 5 and 20, Silverbrook disclosed that the drive component reads optical storage media (column 2, lines 4+).

Regarding claims 8 and 18, Silverbrook disclosed that the printer is an attachable unit (column 3, lines 45+).

Regarding claims 10-12, the method steps recited in the claims are inherently necessitated by the device structure as disclosed by Silverbrook.

Regarding claims 9, 21 and 22, Silverbrook disclosed two drive (a plurality) components (78 and 79) on of which is a magnetic storage drive (78) and another is an optical storage drive (79).

Regarding claims 7 and 17, Silverbrook disclosed all of the claim's limitations as apply to claims 6 and 16 respectively, but did not disclose that the printer is located within the housing of the apparatus.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate said printer within the apparatus housing in order to enhance the versatility of the device, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

*Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

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*Response to Arguments*

3. Applicant's arguments filed on 10/09/02 have been fully considered but they are not persuasive.

After subsequent evaluation of the Silverbrook reference (i.e. after interview conducted on 09/30/02) and after additional review of 35 USC 103 rejection presented in Office Action dated 06/28/02 (paper # 11), it is appears that Applicant's arguments are missing the point, since the main thrust of the arguments is directed to the claim language that specifies "a processor programmed to read and communicate only file information".

It is believed that Silverbrook ('290) reference meets the aforementioned limitation. As it was stated in the rejection (see above) a processor (70) is programmed to read and communicate only the file information since any computer data, including video information is contained in files. Thus, said processor (70) of Silverbrook is inherently reads and communicates only the file (image file in Silverbrook reference) information (Silverbrook, column 2, lines 64+; column 3, lines 65+; and column 4, lines 1+).

The only limitation, which is not present in Silverbrook reference is that, the file information viewable on a visual display or printable by a printer is only the **file directory information**.

The Examiner believes, that it is up to the user of the Silverbrook device what kind of file information to view on the visual display or to print. Thus, the aforementioned recitations recite only a way of intended use of the device, and as it was stated in the rejection, it would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to

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view any desirable information on said visual display, including only the file directory information, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Thus, in view of the above it is believed that Applicants arguments regarding the limitation "processor programmed" are moot, since the Silverbrook reference meets the aforementioned limitation and only limitation which is missing is that directed to the way of using the device, i.e. to what kind of file information (i.e. only file directory information) is viewed on the visual display or printed.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824.

The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Anatoly Vortman  
Primary Examiner  
Art Unit 2835

A.V.  
November 6, 2002

A handwritten signature in dark ink, appearing to read 'A. Vortman', followed by a horizontal line.